



STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

ATTORNEYS AT LAW

1100 NEW YORK AVENUE, N.W. • WASHINGTON, D.C. 20005-3934

PHONE: (202) 371-2600 • FACSIMILE: (202) 371-2540 • www.skgf.com

ROBERT GREENBERG  
EDWARD J. KESSLER  
JORGE A. GOLDSTEIN  
SAMUEL L. FOX\*\*\*  
DAVID K.S. CORNWELL  
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HEIDI L. KRAUS  
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DUSTIN T. JOHNSON\*\*  
MATTHEW J. DOWD\*\*  
AARON L. SCHWARTZ\*\*

\*LIMITED TO MATTERS  
AND PROCEEDINGS BEFORE  
FEDERAL COURTS & AGENCIES  
\*\*REGISTERED PATENT AGENT  
\*\*\*SENIOR COUNSEL

February 15, 2002

RECEIVED  
FEB 21 2002  
TELETRANSMITTER 1600/2900  
WRITER'S DIRECT NUMBER:  
(202) 371-2641  
INTERNET ADDRESS:  
HCARLSON@SKGF.COM

Commissioner for Patents  
Washington, D.C. 20231

Re: U.S. Utility Patent Application  
Appl. No. 08/935,377; Filed: September 22, 1997  
For: **T Cells Specific for Target Antigens and Vaccines Based Thereon**  
Inventors: Maurice Zauderer  
Our Ref: 1821.0010000/EKS/HCC  
Art Unit: 1644

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Petition to Reset Period for Reply;
2. A copy of the original Restriction Requirement; and
3. One return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
February 15, 2002  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Helene C. Carlson  
Agent for Applicant  
Registration No. 47,473

EKS/HCC/ek  
Enclosures  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/935,377	09/22/1997	MAURICE ZAUDERER	PENY4-628885	8588

7590 12/04/2001

STERNE, KESSLER, GOLDSTEIN & FOX P. LLC  
SUITE 600  
1100 NEW YORK AVENUE N.W.  
WASHINGTON, DC 200053934

EXAMINER

DECLOUX, AMY M

ART UNIT

PAPER NUMBER

1644

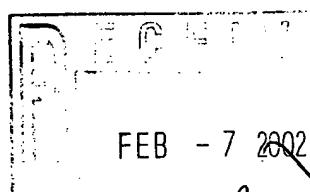
29

DATE MAILED: 12/04/2001

COPY

Please find below and/or attached an Office communication concerning this application or proceeding.

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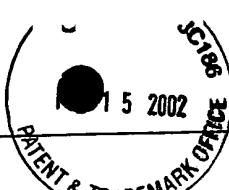
2/7/02

2/21/02

✓WW

Restriction/Election January 4, 2002  
Spot Bar Jan 4, 2002

**Office Action Summary**



Application No. 08/935,377	Applicant(s) Zauderer
Examiner D Cloux, Amy	Art Unit 1644

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Mar 17, 2001

**RECEIVED**  
FEB 21 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 68-120 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 68-120 are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

## DETAILED ACTION

Note: The examiner of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Amy DeCloux, Group Art Unit 1644, Group 1640, Technology Center 1600.

1. Applicant's election with traverse in paper No. 28, filed 9-19-2001 is acknowledged. However in view of the new restriction imposed as detailed below, applicant's traversal is rendered moot.
2. This application contains inventions drawn to patentably distinct species. Applicant is required under 35 USC 121 to elect a specific method of selecting a nucleic acid molecule encoding a target epitope comprising:
  - A) a specific source of heterologous nucleic acid such as tumor cells as recited in claim 92,
  - B) host cells that express a specific MHC molecule, such as MHC Class I as recited in claim 118 or 120,
  - C) a vector of specific origin, such as vaccinia, as recited in claim 77,
  - D) a specific transfer plasmid such as one recited in claim 116,
  - E) a specific helper virus, such as one recited in claim 105 or claim 106.
3. These species are distinct because each of the heterologous nucleic acids, MHC Class I and II molecules, vectors, transfer plasmids and helper viruses are physically and structurally distinct, and therefore represent distinct ingredients in the claimed method. Therefore, the species are patentably distinct species in view of each other. Applicant is required to elect a single disclosed species, even though this requirement is traversed.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 58 is generic.

4. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration

of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.  
Patent Examiner  
Group 1644  
Technology Center 1600  
November 30, 2001

*David A. Saunders*  
DAVID SAUNDERS  
PRIMARY EXAMINER  
ART UNIT 1644

## **Attachment for PTO-948 (Rev. 03/01, or earlier)**

**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

#### **2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

#### **Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.